

Remarks/Arguments

MPEP - 35 U.S.C. 102 - Application of

2131 Anticipation - Application of - 2100 Patentability

2131 Anticipation - Application of 35 U.S.C. 102(a), (b), and (e) [R-1]

35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

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(e) the invention was described in - (1) an application for patent, published under **section 122(b)**, by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international

application filed under the treaty defined in **section 351(a)** shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under **Article 21(2)** of such treaty in the English language; or<

(f) he did not himself invent the subject matter sought to be patented, or

(g)(1) during the course of an interference conducted under **section 135** or **section 291**, another inventor involved therein establishes, to the extent permitted in **section 104**, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros.*

v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.

1987). >"When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions

within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02.< "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01.

Claim Rejection - 35 U.S.C. § 112

Claim 1 – 15 are reject as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

Claim 1 – 15 Cancelled

Claim 2, 3, 6, 7 and 9 are objected to because of the following informalities: the dependency should address to the earlier claim itself only, not to part of the earlier claim as the method of 1c, 1b – as stated.

Claim 2, 3, 6, 7, and 9 are cancelled

Claim Rejection - 35 U.S.C. § 102 (e)

Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Heinonen et al. (U.S. Patent No. 7,107,010 B2).

Regarding claim 1, Heinonen teaches a method of adding an extension phone, i.e., a headset, to a wireless telephone comprising means of interfacing the wireless telephone device with one or more extension phone, i.e., the headset; allowing the wireless device and the extension to be aware of what is happening to the other; and to initiate activity within the wireless device or within the extension phone (refer to Figs. 1-2 and col. 3/lines10-50).

In the above cited prior art of Heinonen et al's patent (US -7,107,010 B2), the teaching is on a wireless headset that uses Bluetooth technology to receive streaming data (Col. 3 line 14 – line 16). The Applicant's invention teaches on linking the wireless telephonic device to an extension phone that can be used to answer and initiate outgoing calls using the cell phone's internal electronics (paragraph # 0050 and # 0063 and # 0077 and Figure 11b). This is not what Heinonen et al taught in their patent. Heinonen et al.'s invention also teaches on a headset that can function without a telephone connection (Col 3 line 20 – line 24). In the Applicant's invention the extension phone cannot work without the cell phone, being that all of the operational components are located in the wireless telephone device (paragraph # 0050). Figure 1 and Figure 2 illustrate a system

that employs radio transmission to communication with a headset. Heinonen et al.'s patent is for a different type of invention than that of the Applicant. There is no mention of wired linkage of an extension phone to a wireless telephonic device (cell phone) in Heinonen et al.'s patent. In the Applicant's patent application there is teaching on using a connection port to physically link by wire a cell phone to an extension phone (figure 1, item 200 and figure 11a & figure 11b). The Applicant's invention teaches on using a connection port (Figure 3) while the cited prior art, Heinonen et al.'s patent does not teach using a radio transmission (Figure 2). Nor does Heinonen et al.'s patent teach on an correlation between the cell phone keypad and the keypad of the extension phone being an one – to – one circuit match up as it taught in the Applicant's invention (figure 11 b). There is no teaching on the headset of Heinonen et al.'s patent being able to establish an outgoing call. There is no anticipation of the Applicant's invention. Both the Applicant and Heinonen et al inventions are different in nature and function; therefore the latter should not be considered anticipatory to the former.

FIG. 1 is a representation of a short-range radio headset/terminal linked to a location aware based server via an Access Point for receiving streaming voice or location aware services and incorporating the principles of the present invention;

FIG. 2 is a representation of the short-range terminal and headset design in

FIG. 1 for receiving streaming voice or location aware services while paired with a host device;

FIG. 2A is a representation of a switching module for initiating or terminating an "idle mode" for the terminal and headset of FIG. 2;

Claim 1 is allowable.

Claim 2, 3, 4, 5, 6, 7, 8, 9, and 10 are allowable as dependents of an allowed claim.

The rest of claims 2-10 simply refer to the communication between the headset and the wireless telephone and the interaction between the two for dialing, receiving incoming calls, and/or ending incoming calls and the detection to answer the phone call from the extension unit or the headset (col. 6/line 21 to col. 7/line 55; and Fig. 2 and col. 7/line 57 to col. 8/line 58).

In the above Examiner cited prior art of Heinonen et al's patent (US -7,107,010 B2), the teaching is on streaming data (Col. 6 line 31 – line 35) and multi-channel switching (Col. 7 line 1 – line 3). There is no teaching on an extension phone initiating an outgoing call on a wireless telephonic device.

Claims 2 – 10 are allowable

Regarding claims 11-15, these claims are rejected for the reasons as disclosed above, which mainly refer to the communication between the headset regarded as an extension unit and the wireless telephone device.

In the above Examiner cited prior art of Heinonen et al's patent (US -7,107,010 B2), rejection of Claims 11-15 is based upon teachings on communication between a headset and wireless telephonic device. The word "Headset" does not even appear in the cited claims of the Applicant's patent application, therefore these claims were not properly rejected. If the teaching upon which the rejection is based in not founded, then the rejection can not be valid, no similar teaching in found in prior art. Heinonen et al.'s patent is different from that of the Applicant's invention.

11. A method for merging incoming and outgoing call from both wireless and wired communication into a single device, comprising: (a) a mean by which a wireless device can communicate through a line phone; (b) a mean by which a wireless device can be used to make outgoing calls through a wired telephone network; (c) a mean by which a wired phone can be used to answer call to a wireless device; (d) a mean by which a wired phone can be used to combine calls on a wired and wireless

12. The method of claim 11, wherein the line phone can monitor for and detect incoming calls on the wireless device.

13. The method of claim 11, wherein the line phone can dial a phone number on the wireless device.

14. The method of claim 13, wherein a call made from the line phone is conducted over the wireless communication network via the wireless device. (b) codes for charging one or more wireless devices while being used as part of a communication system.

15. A system of adding an extension phones to a wireless telephonic device, comprising: (a) codes for interfacing the a wireless telephonic device with one or more extension phone(s); (b) codes for allowing each device to be aware of what is happening in the other device; (c) codes for allowing each device to initiate activity within the other device; (a) codes for coordinating the activity with the wireless device and the extension phone. (b) mean for allowing each device to be aware of what is happening in the other device; (c) mean for allowing each device to initiate activity within the other device; (b) mean for coordinating the activity with the wireless device and the extension phone.

Claims 11 – 15 are allowable.

Summary Response To Examiner's Arguments

According to MPEP "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). >"When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001)..."

Therefore Heinonen et al. (U.S. Patent No. 7,107,010 B2) to anticipate the Applicant, there would have to be teaching on a one to one relationship between the buttons of the

cellular phone and the extension phone, allowing for combining the two keypads into a common keypad totally negating the need for interfacing components.

In the cited prior art of Heinonen et al's patent (US -7,107,010 B2) does not teach on placing the components needed for making a call from an extension phone within a cellular phone, using the native circuitry of a cellular phone to enable an extension phone to make and receive wireless calls, on an extension phone specifically designed to work with a wireless phone, or on linking an extension phone to a wireless device via a connection port using a one to one linkage of the keypad button of both the extension phone and wireless phone.

In both Figure 1 and Figure 2 the cited prior (Heinonen et al.) teaches on the use of wireless communication between a headset/handset and a wireless device. There is no teaching on linkage via a connection port as in the Applicant's invention. Heinonen et al's patent does not teach on locating all of the components required to link a wireless telephonic device to an extension phone inside of the telephonic device (Applicant's patent application paragraphs # 0066 and # 0077). Therefore Heinonen et al's patent can not be said to anticipate the Applicant's invention.

Listing of Claims:

Claim 1 - 15 (Cancelled):

Claims

Claim 16 (new): A system for adding a specifically designed extension phones to a wireless telephonic device, comprising:

(a) a means for an extension phone designed to work by utilizing the circuitry of an attached wireless device;

(b) a means for interfacing the circuitry of a wireless telephonic device with one or more wired extension phones via a connection port;

(c) a means for the wireless device to share the telephonic functionality of its internal circuitry with the extension phone by combining the keypad circuitry of the extension phone with that of the wireless device;

(d) a means for the extension phone to perform telephonic functions by conveying keypad input to the circuitry of the wireless device;

(e) a means for the attached extension phone to perform telephonic functions by conveying audio between the handset and the wireless device speaker and microphone circuitry.

Claim 17 (new): The system of claim 16, wherein a wireless telephonic device is able to detect when the extension phones goes off hook in response to signaling of a incoming call.

Claim 18 (new): The system of claim 17, wherein the circuit for each button on the wireless telephonic device keypad is activated when the same button on the extension phone keypad is pressed.

Claim 19 (new): The system of claim 18, wherein a wireless telephonic device circuitry terminates incoming and outgoing call activity when extension phones goes on hook.

Claim 20 (new): The system of claim 19, wherein the extension phone's audio circuitry transmits and receives audio to the wireless telephonic device.

Claim 21 (new): The system of claim 20, wherein the extension phone circuitry extends the operational functionality wireless telephonic device.

Claim 22 (new): A wireless telephonic device able to receive and transmit input from an attached specifically designed wired extension phone comprising a connection port with pins that have a one to one relationship with each button on the wireless telephonic device keypad, function keys, and audio circuitry, enabling the wireless telephonic device to extend operational aspects of the keypad buttons, and function keys, and audio circuitry to the extension phone, wherein the wireless telephone device extending it's circuits for capturing dialed phone numbers to the extension phone keypad, and extend its audio circuitry out to both the speaker and microphone in the extension phone, and extend its function key circuits out to the extension phone, the extension phone having a connection port with pin-sockets that form a one to one relationship the extension

phone's keypad buttons, function key, and audio circuits, thereon the matching of the pins and the pin-sockets negating the need for the extension phone to have any interfacing component contained within its structure.

Claim 23 (new): The method of claim 22, wherein a wireless telephonic device circuitry is able to detect when the extension phones goes off hook in response to an incoming call.

Claim 24 (new): The method of claim 23, wherein a wireless telephonic device circuitry is able to detect when the extension phones goes off hook for dialing of an outgoing call.

Claim 25 (new): The method of claim 24, wherein a wireless telephonic device is able to detect when the extension phones goes on hook indicating the termination of calling activity.

Claim 26 (new): A method for adding a specifically extension phones to a wireless telephonic device, comprising:

- (a) a means for an extension phone designed to work by utilizing the circuitry of an attached wireless device;
- (b) a mean for interfacing the circuitry of a wireless telephonic device with one or more wired extension phones via a connection port;
- (c) a mean for the wireless device to share the functionality of its circuitry with the extension phone;

(d) a mean for the wireless device to share the functionality of its circuitry with the extension phone;

(e) a mean for the extension phone to perform telephonic functions using the circuitry of the wireless device;

(f) a mean for the attached extension phone to initiate outgoing calls by transmitting the pressing of keypad buttons and function keys to the wireless device via share circuitry;

(e) a mean of allowing any attached wireless device to extend its capabilities to the extension phone via share circuitry.

Claim 27 (new): The method of claim 26, wherein a wireless telephonic device is able to detect when the extension phones goes off hook in response to signaling of a incoming call.

Claim 28 (new): The method of claim 27, wherein the circuit for each button on the wireless telephonic device keypad is activated when the same button on the extension phone keypad is pressed.

Claim 29 (new): The method of claim 28, wherein a wireless telephonic device circuitry terminates incoming and outgoing call activity when extension phones goes on hook.

Claim 30 (new): The method of claim 29, wherein the extension phone audio circuitry transmits and receives audio to the wireless telephonic device.

Claim 31 (new): The method of claim 30, wherein the extension phone circuitry extends the operational functionality wireless telephonic device.

Claim 32 (new): The system of claim 16, wherein software coding stored within an a wireless device enable an extension phone to access to the circuitry of the wireless device via connection port pins.

Claim 33 (new): The system of claim 32, wherein said coding enables a wireless device to detect the pressing of buttons on the extension phone keypad via a connection port linkage of said wireless device and the extension phone.

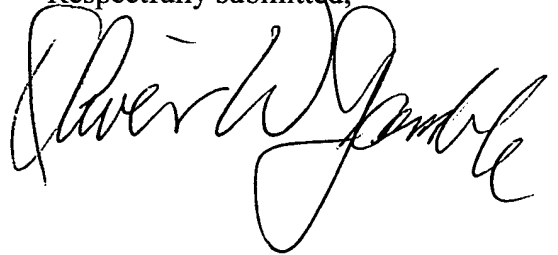
Claim 34 (new): The system of claim 34, wherein coding stored on the wireless device allows the extension phone to function as a physical extension of the wireless device enabling the pressing of buttons on the extensions phone to dial phone number on the wireless device.

Claim 35 (new): The system of claim 33, wherein coding stored on the wireless device allows the extension phone to function as a physical extension of the wireless device in all telephonic usage.

Interview with Examiner

Interview with examiner was helpful in understanding the need to restrict the scope of my claims to the subject matter that is different from prior art.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Oliver W. Gamble". The signature is written in a cursive, flowing style with large, connected letters.